PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Hideki MATSUNAGA

Group Art Unit: 2172

Application No.: 09/923,440

Examiner: A. Ly

Filed: August 8, 2001

Docket No.: 110331

For: OBJECT MANAGEMENT METHOD AND SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

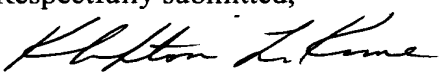
Sir:

Applicants hereby request review of the May 5, 2005 Final Rejection in this application. Check No. 170495 in the amount of $130.00 in payment of the petition fee set forth in 37 CFR §41.20(a) is attached.

The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No.15-0461. Two duplicate copies of this request are enclosed.

No Amendments are being filed at this time. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the attached sheets.

Respectfully submitted,



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Date: September 6, 2005

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OLIFF & BERRIDGE, PLC
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REMARKS

Claims 1-18 are pending in this application and stand finally rejected. The May 5, 2005 Final Office Action rejects claims 1-18 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent Application Publication No. 2001/0056421 A1 to Tada et al. ("Tada") in view of U.S. Patent No. 6,189,032 to Susaki et al. ("Susaki").

Applicants respectfully submit that the legal and factual basis of the prior art rejection contains "a clear error in fact or other deficiency" as specified in the July 12, 2005 *Official Gazette* Notices. The Final Office Action asserts that Tada discloses every feature recited in independent claims 1 and 10, except for "setting an identifier for identifying the object and performing access control for the object." The Office Action further asserts, on page 4, lines 1-2, that Susaki teaches "performing the access control via the access control list and identifier of object such as file or service stored in the table."

Applicant respectfully submits that Susaki does not teach that which is asserted by the Office Action.

The first clear error in fact resides in the Office Action's misstatement of the teachings of Susaki by referring to an identifier of an object such as a file. Nowhere in Susaki can such a teaching be found.

As noted in the first paragraph on page 4 of the June 15, 2005 Request for Reconsideration ("Request"), the Office Action relies on Figs. 4, 5 and 7 of Susaki as allegedly disclosing "setting an identifier for identifying the object," as recited in independent claims 1 and 10.

As discussed in the second paragraph on page 4 of the Request, Figs. 4 and 7 of Susaki clearly only show user identifiers and Fig. 5 clearly only shows service identifiers. Neither of these identifiers disclosed by Susaki can reasonably be considered to be an object identifier for retrieving an object as recited in independent claims 1 and 10. As previously argued in the Request, none of the information in the files of these tables relates to an object

identifier for identifying an object (having a retrieval condition as recited in claims 1 and 10).

As discussed in the third paragraph on page 4 of the Request, Susaki teaches only that an approval condition is retrieved. Neither an identified user nor an identified service is retrieved according to Susaki.

Moreover, as discussed in the fourth paragraph on page 4 of the Request, Susaki provides no disclosure of retrieval of a file.

Susaki does not disclose setting an identifier for identifying any object that has a retrieval condition. The Office Action's statement to the contrary regarding the alleged disclosure in Susaki of an "identifier of object such as file" is a clear error in fact.

The July 7, 2005 Advisory Action repeats this error in citing the Abstract and selected text of Susaki. The Abstract and text of Susaki do not teach that which is asserted by the Advisory Action. In particular, the Abstract clearly only discusses "access to a service by a user." There is simply no disclosure in Susaki of "a certain operation . . . associated to the retrieval [of] a document or object on the system" as asserted by the Advisory Action (emphasis added). The text cited by the Advisory Action simply does not set forth what the Advisory Action asserts: "service supply control means" and "approval condition retrieval means for retrieving an approval condition" (col. 3, lns. 11-13); "the server of the present invention provides at least one service" (col. 4, lns. 36-37); and "approval condition retrieval means for retrieving an approval condition" (col. 4, lns. 51-52).

The second clear error in fact resides in the Office Action's failure to identify any disclosure in Susaki regarding performing access control for the object, as recited in claims 1 and 10. As discussed in the first paragraph on page 5 of the Request, the Office Action alleges that Susaki discloses performing access control, but fails to address the language of the claims. Claims 1 and 10 recite performing access control for the object matching the retrieval condition and the identifier on the basis of the access right, not "performing access control via the access control list and identifier of object" as sated in the Office Action.

As discussed in the second paragraph on page 5 of the Request, the access control of Susaki is access control of services, not objects having retrieval conditions and identifiers to match. The access control disclosed by Susaki does not relate at all to retrieval conditions of objects or identifiers of objects.

These clear errors in fact undermine the factual basis on which the Office Action relies. Thus, these errors lead to a legal deficiency in the Office Action's conclusion of obviousness because each and every feature recited in the claims is not taught by the applied references.

The Office Action's conclusion of obviousness also suffers from a second legal deficiency, namely, lack of a proper motivation to combine the references.

As discussed in the last paragraph on page 5 of the Request, neither of the applied references discloses or suggests the motivation alleged by the Office Action. Because Tada admittedly fails to disclose or suggest performing access control at all and the access control disclosed by Susaki does not relate at all to a retrieval condition of an object, neither reference can reasonably be considered to provide one skilled in the art with the motivation alleged by the Office Action.

Further, as discussed in the first paragraph on page 6 of the Request, a person skilled in the art would not have been motivated to apply the teachings of access control of services to the systems and methods of Tada because Tada does not relate to services. Tada relates only to retrieval data for document retrieval and Susaki relates only to access control of services. Neither reference discloses anything with regard to the subject matter of the other reference.

Therefore, the Office Action fails to set forth a proper motivation to combine the teachings of Tada and Susaki as required to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a). Absent a proper motivation, the Office Action should be considered to be an impermissible hindsight reconstruction of Applicant's claims.

In view of the foregoing and the June 15 Request, Applicant respectfully submit that the prior art rejection represents clear error and should be reversed.

Respectfully submitted,

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Klifton L. Kime
Registration No. 42,733

JAO:KLK/hs

Date: September 6, 2005

Attachment:
Notice of Appeal and Petition for Extension of Time

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